

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION**

HYOSUNG TNS, INC.,

Plaintiff,

v.

DIEBOLD NIXDORF, INC.,

Defendant.

Civil Action No. 3:16-cv-364

DEFENDANTS' MOTION TO DISMISS UNDER RULE 12(b)(6)

Defendant Diebold Nixdorf, Inc. respectfully files this motion to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(6) for failure to state a claim for relief. As elaborated in the accompanying Memorandum of Support, the First Amended Complaint in this case must be dismissed because the only patent alleged to be infringed, U.S. Patent No 8,523,235 (“’235 Patent”), was held to be invalid as a matter of law by a superior tribunal, the United States Court of Appeals for the Federal Circuit. *Diebold Nixdorf, Inc. v. Int’l Trade Comm’n*, 899 F.3d 1291, 1294 (Fed. Cir. 2018). The Federal circuit held that the term “cheque standby unit” in each claim of the ’235 patent is purely functional and thus should be construed under § 112, paragraph 6, and that the specification failed to disclose any structure for performing that function. Thus, the Federal Circuit held that the claims were invalid-as-indefinite as a matter of law. Accordingly, Diebold respectfully requests the Court to dismiss this action pursuant to Rule 12(b)(6) because Hyosung cannot state a claim for relief based on a patent held invalid by the Federal Circuit.

Dated: April 11, 2019.

Respectfully submitted,

/s/ David S. Frist

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CERTIFICATE OF SERVICE

I hereby certify that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system on April 11, 2019.

/s/ David S. Frist

David S. Frist